19. (Amended) A system for determining potential licensees for a source patent portfolio comprising one or more patents where each patent has one or more references cited thereto, the system comprising:

A6

means for devising a set of associated patents wherein each patent in the set of associated patents i) cites as a reference a patent in the source patent portfolio or ii) is cited as reference by a patent in the source patent portfolio;

means for processing all of the patents in the set of associated patents to establish a set of assignees contained in the set of associated patents;

means for establishing a set of remaining assignees by removing from the set of assignees all assignees that are currently licensed; and

means for organizing the set of remaining assignees according to a ranking criteria.

A7

25. (Amended) The system of claim 19 wherein the ranking criteria is expressed as a ratio of the total number of patents held by an assignee to the number of patents held by that assignee in the set of associated patents.

REMARKS

The Examiner objected to the Abstract of the Specification as not complying with the recommendation that the abstract should be between 50 and 150 words, and also to other matters of form. Applicants have amended the abstract of the specification to comply with the Examiner's comments. Applicants have also amended claims 1, 7, 10, 16, 19, and 25 to more particularly point out what is considered to be the invention, and the title, to more accurately describe the claimed invention. No new matter has been added by these amendments.

Response to Claim Rejections Under 35 U.S.C. 102:

In the Office Action dated July 29, 2002, the Examiner rejected Claims 1 through 27 under 35 U.S.C. §102(e) as being anticipated by Rivette et al. (U.S. Patent 5,991,751). Applicants traverse the rejection and request reconsideration.

Claims 1-27:

The Examiner rejected independent claims 1, 10, and 19 under 35 U.S.C. §102(e) as being anticipated by Rivette. Because the remaining dependent claims all depend from these three independent claims, allowance of claims 1, 10, and 19 will result in the allowance of all claims.

The Applicants' invention relates generally to a system for identifying assignees that are potential licensees of patents that are associated with a particular set of patents (i.e., patents in a source patent portfolio) that are of interest to a user. The patents in the source patent portfolio may be, for example, all of the patents owned by an assignee (who may in turn be the user). The patents in the source patent portfolio will undoubtedly cite as references numerous documents, such as other patents, technical articles, etc. The associated patents may include a set of patents that cite as a reference any patent in the source patent portfolio, or they may be a set of patents that are themselves cited as references by patents in the source patent portfolio. Thus, the associated patents may have issued before or after the patents in the source patent portfolio.

It is from the set of associated patents that assignees that are not currently licensees are listed and ranked, as claimed. Ranking unlicensed assignees allows users to readily determine which assignees of associated patents are potential licensees of the patents in the source patent portfolio. Ranking the assignees according to some specific criteria can give a user of the system insight into assignees with a concentration in the same technical area of the patents in the source patent portfolio, although other uses are possible.

To anticipate, a cited reference must disclose each and every element of a claim. Rivette, however, fails to show or suggest the steps of 1) establishing a set of unlicensed assignees and 2) organizing assignees according to a ranking criteria, as required by claims 1, 10, and 19.

Rivette shows a system that creates "patent citation reports" that are used by operators (natural persons), but the system goes no further than generating the reports. Rivette illustrates the patent citation reports generated by his system in Figures 61-65. Rivette, col. 102, lines 17-18. Figure 62, reproduced below, represents one such "patent citation report".

As shown by column 6204 in the figure, ownership status of patents is merely listed in the report. Rivette does not establish or suggest establishing a set of "remaining assignees" that are unlicensed, as required by claims 1, 10, and 19. Thus, whatever actions Rivette does suggest are not performed on the same group of assignees as taught by Applicants, and a user of Rivette's system would not be able to readily determine which assignees are also potential licensees from the patent citation report shown.

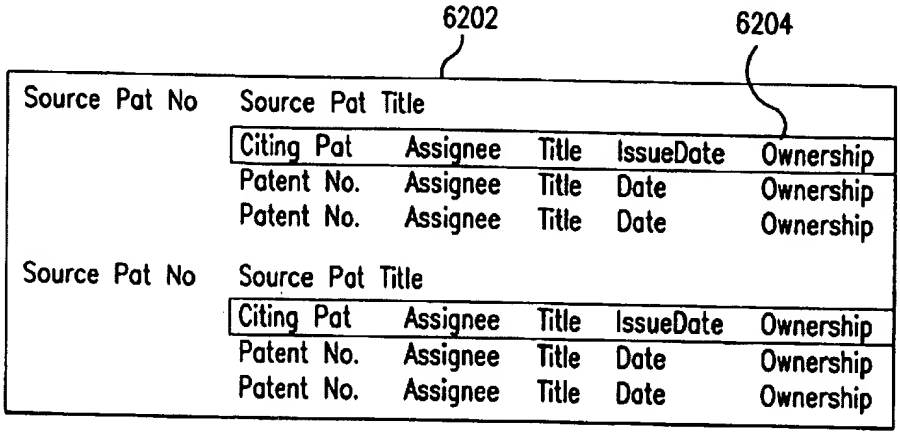

FIG.62

In addition, Rivette neither shows nor suggests organization according to a ranking criteria of remaining assignees as required by Applicants' claims. Rivette suggests only that *some*

McDonnell Boehnen Hulbert & Berghoff
300 South Wacker Drive, 32nd Floor
Chicago, IL 60606
(312)913-0001
Fax: (312) 913-0002

Serial No.: 09/560,397
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Filed: 4/28/2000

significance may be attached to the overall number of patents a particular assignee has, or to how recently an assignee's patents were filed or issued. Rivette, col. 102, lines 44-45 and 58-60. Thus, Rivette only suggests that a user can make a subjective evaluation while viewing a patent citation report that displays unranked assignees, as shown above. Rivette does not show or suggest organizing assignees according to a ranking criteria, and Rivette shows no ranking or organization of an assignee (or assignees) as compared to other assignees, as claimed by Applicants. Because of this, a user of Rivette's system could not easily evaluate potential licensees of a source patent portfolio, especially in a "crowded field," where it would be possible to have hundreds of assignees about which a user must make a subjective determination. According to the specification, the patents displayed in Figure 62 "are displayed by patent number," which gives a user no insight into the relative importance of a source patent to an assignee. Indeed, the most important potential licensee could be displayed at the bottom of the list in Figure 62.

Claims 6-7, 15-16, and 24-25 further distinguish over Rivette because Rivette does not organize assignees using either *a*) the frequency of occurrence for each assignee in the set of associated patents, as required by claims 6, 15, and 24, or *b*) the ratio of the total number of patents held by an assignee to the number of patents held by that assignee in the set of associated patents as a ranking criteria, as required by claims 7, 16, and 25. As discussed above, Rivette requires a subjective evaluation of a patent citation report to determine (but not to rank, as compared to other assignees) an assignee's significance using the overall number of patents in a patent citation report held by an assignee, or using the date the assignee's patents were filed or issued.

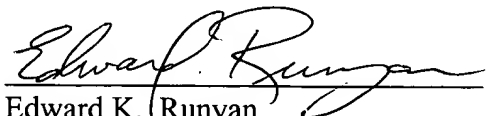
Conclusion

Because Rivette's system does not show or suggest organizing assignees according to a ranking criteria, and if it did, it would organize a different group of assignees than Applicant's invention, Rivette fails to anticipate claims 1, 10, and 19. Claims 1, 10, and 19 are therefore allowable, and notice to that effect is requested. Because claims 2-9, 11-18, and 20-27 depend ultimately from claims 1, 10, and 19, allowance of claims 2-9, 11-18, and 20-27 will follow directly from the allowance of claims 1, 10, and 19. In addition, claims 6-7, 15-16, and 24-25 are patentable over Rivette because Rivette does not show or suggest a specific criteria for organizing assignees as required by those claims.

Applicants submit that the present application is now in condition for allowance, and notice to that effect is hereby requested. Should the Examiner feel that further dialog would advance the subject application to issuance, she is invited to telephone the undersigned at any time at (312) 935-2373.

Respectfully submitted,

Date: 10/24, 2002



Edward K. Runyan
Registration No. 43,067
Attorney for Applicants
phone: (312) 935-2373

[METHOD, COMPUTER PROGRAM PRODUCT, AND] SYSTEM

FOR [DETERMINING] IDENTIFYING POTENTIAL LICENSEES OF A SOURCE

PATENT PORTFOLIO

ABSTRACT

[The present invention will determine a ranked list of assignees that are likely candidates for licensing]A list of potential licensees of a patent portfolio can be generated from a source patent portfolio. [The assignees are picked from a set of patents that is related or associated with]To identify the licensees, the source patent portfolio [and have not already been licensed. A set of associated patents is determined that are]comprising, for example, all the patents owned by a particular entity, can be created. Next, a list of a set of patents that are related to or associated with the patents in the source patent portfolio is generated. The unlicensed assignees of patents in this set of related patents are organized according to various criteria. For example, the assignees could be ranked based on the ratio of total patents held by an assignee to the number of patents in the set of associated patents held by that assignee. Such rankings can provide [associated or related with a source patent portfolio. For example, the set of associated patents could contain patents having "backwards" references (*i.e.*, patents cited as a reference by a patent in the source patent portfolio), "forwards" references (*i.e.*, patents that cite as a reference one]an indication of assignees that may be potential licensees of the patents in the source patent [portfolio),]portfolio. [or "shared" references (*i.e.*, patents that cite as reference at least on of the references cited by a patent of the source patent portfolio). Furthermore, the set of associated patents could be expanded upon by applying the same reference analysis to the current set of associated patents to add patents thereto that are relevant. This process can be done recursively to a specified number of levels or otherwise be stopped according to a specific criteria (*e.g.*, certain number of patents, etc.). A list of all the assignees in the set of associated patents is determined and those assignees that are already licensed or for some other reason can be readily eliminated are subtracted from the

list. The list of assignees (*e.g.*, remaining assignees) is then organized according to a ranking criteria and presented to the user.]

1. (Amended) A method for determining potential licensees for a source patent portfolio [composed of] comprising one or more patents, [where each patent has one or more references cited thereto,] the method comprising:

devising a set of associated patents wherein each patent in the set of associated patents i) cites as a reference a patent in the source patent portfolio or ii) is cited as a reference by a patent in the source patent portfolio;

processing all of the patents in the set of associated patents to [determine] establish a set of [the] assignees contained in the set of associated patents;

establishing a set of remaining assignees by removing from the set of assignees all assignees that are currently licensed; and

organizing the set of remaining assignees according to a ranking criteria.

7. (Amended) The [A] method of [as recited in] claim 1 wherein the ranking criteria is expressed as a ratio of the total number of patents held by an assignee to the number of patents [meeting the criteria for the] held by that assignee in the set of associated [correlated] patents.

10. (Amended) A computer program product comprising:

a computer usable medium;

computer readable instructions embodied on said computer useable medium for determining potential licensees for a source patent portfolio [composed of] comprising one or more patents [where each patent has one or more references cited thereto], the instructions directing a computer to perform the steps of:

devising a set of associated patents wherein each patent in the set of associated patents i) cites as a reference a patent in the source patent portfolio or ii) is cited as a reference by a patent in the source patent portfolio;

processing all of the patents in the set of associated patents to [determine] establish a set of [the] assignees contained in the set of associated patents;

establishing a set of remaining assignees by removing from the set of assignees all assignees that are currently licensed; and

organizing the set of remaining assignees according to a ranking criteria.

16. (Amended) The [A] computer program product of [as recited in] claim 10 wherein the ranking criteria is expressed as a ratio of the total number of patents held by an assignee to the number of patents [meeting the criteria for the] held by that assignee in the set of associated [correlated] patents.

19. (Amended) A system for determining potential licensees for a source patent portfolio [composed of] comprising one or more patents where each patent has one or more references cited thereto, the system comprising:

means for devising a set of associated patents wherein each patent in the set of associated patents i) cites as a reference a patent in the source patent portfolio or ii) is cited as reference by a patent in the source patent portfolio;

means for processing all of the patents in the set of associated patents to [determine] establish a set of [the] assignees contained in the set of associated patents;

means for establishing a set of remaining assignees by removing from the set of assignees all assignees that are currently licensed; and

means for organizing the set of remaining assignees according to a ranking criteria.

25. (Amended) The [A] system of [as recited in] claim 19 wherein the ranking criteria is expressed as a ratio of the total number of patents held by an assignee to the number of patents [meeting the criteria for the] held by that assignee in the set of associated [correlated] patents.